

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Kenneth F. Buechler

Title: DIAGNOSTIC DEVICES AND
APPARATUS FOR THE
CONTROLLED MOVEMENT OF
REAGENTS WITHOUT
MEMBRANES

Appl. No.: 10/697,351

Filing Date: 10/29/2003

Examiner: Alexander, Lyle

Art Unit: 1743

TERMINAL DISCLAIMER OF U.S. PATENT NO. 5,458,852

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Your Petitioner, Biosite, Inc., having its principal place of business at 11030 Roselle Street, Suite D, San Diego, CA 92121, represents that it is the owner of the entire right, title, and interest in and to U.S. Patent Application Serial No. 10/697,351, filed October 29, 2003, by virtue of an Assignment from inventor Buechler to Biosite Diagnostics in U.S. Patent Application Serial No. 09/613,650 filed and recorded on October 14, 2003, on Reel/Frame 014048/0892 in the United States Patent and Trademark Office, USPTO Assignment data of which is attached hereto as EXHIBIT A, by virtue of U.S. Patent Application Serial No. 10/697,351 being a continuation of U.S. Patent Application Serial No. 09/613,650, and by virtue of a name change from Biosite Diagnostics in U.S. Patent Application Serial No. 10/697,351,

which change is recorded under reel/frame 013705/0660, USPTO Assignment data for which is attached as Exhibit A.

Further, your Petitioner represents that it is the owner of U.S. Patent No. 5,458,852, which issued on U.S. Patent Application No. 07/887,526, filed May 21, 1992, by virtue of an Assignment from inventor Buechler to Biosite Diagnostics in U.S. Patent Application No. 07/887,526 filed and recorded on September 21, 1992, on Reel/Frame 006243/0843, in the United States Patent and Trademark Office, USPTO Assignment data for which is attached hereto as EXHIBIT B, and by virtue of a name change from Biosite Diagnostics in U.S. Patent Application Serial No. 10/697,351, which change is recorded under reel/frame 013705/0660, USPTO Assignment data for which is attached as EXHIBIT B.

Your Petitioner, Biosite, Inc., hereby disclaims the terminal part of the term of any patent granted on the above identified patent application which would extend beyond the full statutory term, as shortened by any terminal disclaimer, of U.S. Patent 5,458,852, and hereby agrees that any patent so granted on the above identified patent application shall be enforceable only for and during such period that the legal title to U.S. Patent 5,458,852 shall be the same as the legal title to any patent granted on the above identified patent application, this agreement to run with any patent granted on the above identified patent application and to be binding upon the grantee, its successors or assigns.

In making the above disclaimer, Petitioner does not disclaim any terminal part of any patent granted on the above identified patent application, prior to the full statutory term of U.S. Patent 5,458,852 as defined in 35 U.S.C. §§154-156 and 173, in the event that U.S. Patent 5,458,852 expires for failure to pay a maintenance fee, is held unenforceable or is found invalid in a final judgment by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR §1.321(a), has all claims canceled by a reexamination certificate or as a result of an interference proceeding, or is otherwise not deemed to provide the rights conveyed by 35 USC §154, prior to the full statutory term of U.S. Patent 5,458,852 as defined in 35 USC §§154-156 and 173, except for the separation of legal title stated above.

Further, Petitioner does not disclaim any terminal part of a patent granted on the above identified patent application that would extend beyond the present termination of U.S. Patent 5,458,852, in the event that such present term is extended by virtue of compliance with the conditions for term extension of any present or future patent term extension provisions of the patent law, including but not limited to 35 U.S.C. §§155, 155A or 156, and without waiving Petitioner's right to extend the term of a patent granted on the above identified patent application to the extent provided by law.

The undersigned, being the Attorney of Record for the above identified patent application, and duly authorized to act on behalf of Petitioner, certifies that he has reviewed the assignment information from the USPTO attached as EXHIBITS A and B, and to the best of his knowledge and belief, legal title to the above identified patent application and U.S. Patent 5,458,852 rests with Petitioners, Biosite, Inc. The undersigned declares that all statements made herein of his own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the above-identified application or any patent issuing therefrom.

Respectfully submitted,

Date 01/25/2007

By Barry S. Wilson

FOLEY & LARDNER LLP
P.O. Box 80278
San Diego, CA 92138-0278
Telephone: (858) 847-6722
Facsimile: (858) 792-6773

Richard J. Warburg (Reg. no. 32,327)
Attorney for Applicant
By Barry S. Wilson (Reg. No. 39,431)

Attachments:

- Exhibit A: Assignment data for U.S. App. No. 09/613,650 (Private PAIR: January 24, 2006)
- Exhibit B: Assignment data for U.S. Pat. No. 5,458,852 (USPTO Assignment website: January 25, 2007)

Exhibit A: Assignment data for U.S. Pat. No. 09/613,650 (Private PAIR: January 24, 2006)

Total Assignments: 2

Application #: 09613650 **Filing Dt:** 07/11/2000 **Patent#:** NONE **Issue Dt:**
Inventor: KENNETH F. BUECHLER
Title: DIAGNOSTIC DEVICES FOR THE CONTROLLED MOVEMENT OF REAGENTS WITHOUT
MEMBRANES

Assignment: 1

Reel/Frame: 013705/0660 **Recorded:** 060/4/2003 **Pages:** 3

Conveyance:

CHANGE OF NAME (SEE DOCUMENT FOR DETAILS)

Assignor: BIOSITE DIAGNOSTICS, INC.
Exec Dt: 06/20/2001

Assignee:

BIOSITE, INC.
11030 ROSELLE STREET
SUITE D
SAN DIEGO, CALIFORNIA 92121

Correspondent:

FOLEY & LARDNER
MICHAEL A. WHITTAKER
P.O.BOX 80278
SAN DIEGO, CA 92138

Assignment: 2

Reel/Frame: 014048/0892 **Recorded:** 10/14/2003 **Pages:** 3

Conveyance: ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS)

Assignor: BUECHLER, KENNETH F., PH.D.
Exec Dt: 10/10/2003

Assignee:

BIOSITE DIAGNOSTICS, INC.
11030 ROSELLE STREET
SUITE D
SAN DIEGO, CALIFORNIA 92121

Correspondent:

FOLEY & LARDNER
BARRY S. WILSON
P.O. BOX 80278
SAN DIEGO, CA 92138

**Exhibit B: Assignment data for U.S. Pat. No. 5,458,852 (USPTO Assignment website
January 25, 2007)**

Total Assignments: 2

Patent #: 5458852 **Issue Dt:** 10/17/1995 **Application #:** 07887526 **Filing Dt:** 05/21/1992

Inventor: KENNETH F. BUECHLER

Title: DIAGNOSTIC DEVICES FOR THE CONTROLLED MOVEMENT OF REAGENTS WITHOUT
MEMBRANES

Assignment: 1

Reel/Frame: 006243/0843

Recorded: 09/21/1992

Pages: 3

Conveyance:

ASSIGNMENT OF ASSIGNORS INTEREST.

Assignor: KENNETH FRANCIS BUECHLER

Exec Dt: 09/14/1992

Assignee:

BIOSITE DIAGNOSTICS INCORPORATED

11030 ROSELLE STREET STE. D

SAN DIEGO, CALIFORNIA 92121

Correspondent:

LYON & LYON

611 WEST SIXTH ST.

34TH FL.

LOS ANGELES, CA 90017

ATTN: MARY S. CONSALVI, ESQ.

Assignment: 2

Reel/Frame: 013705/0660

Recorded: 06/04/2003

Pages: 3

Conveyance: CHANGE OF NAME (SEE DOCUMENT FOR DETAILS).

Assignor: BIOSITE DIAGNOSTICS, INC.

Exec Dt: 06/20/2001

Assignee:

BIOSITE, INC.

11030 ROSELLE STREET

SUITE D

SAN DIEGO, CALIFORNIA 92121

Correspondent:

FOLEY & LARDNER

MICHAEL A. WHITTAKER

P.O. BOX 80278

SAN DIEGO, CA 92138